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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/825,132	04/16/2004	Sadayuki Iwai	250970US2CONT	7997
22850	7590	12/29/2004	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			LEE, SUSAN SHUK YIN	
			ART UNIT	PAPER NUMBER
			2852	

DATE MAILED: 12/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/825,132

Applicant(s)

IWAI, SADAYUKI

Examiner

Susan S. Lee

Art Unit

2852

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 April 2004.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-10 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 10/136,279.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 4/16/04.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____

DETAILED ACTION

Claim Objections

Claims 4, 6, 7, and 10 are objected to because of the following informalities:

As to claim 4, line 8, "the primary transfer section" lacks antecedent basis.

As to claim 6, line 4, "103" and "1010" should be -- 10^3 -- and -- 10^{10} -- ,
respectively.

As to claim 7, line 4, "103" and "1010" should be -- 10^3 -- and -- 10^{10} -- ,
respectively.

As to claim 10, line 3, "the developing unit" lacks antecedent basis.

Appropriate correction is required.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-10 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6, 8, and 9 of U.S. Patent No. 6,792,222. Although the conflicting claims are not identical, they are not patentably

distinct from each other because the claims of US Patent No. 6,792,222 read on the instant invention's claims.


Claims 1, 5, and 8 of US Patent No. 6,792,222 recite the same elements that read on the method of the instant invention's claim 1. The latent image formation unit forms an electrostatic latent image on the surface of the image holder; a developing unit develops the electrostatic latent image by using a charged toner; a transferring unit that transfers a toner image onto an image-receiving unit by applying a transfer bias to the image-receiving unit; and an amount of the transfer bias is set such that potential differences between surface potentials of an image section and a non-image section of the image holder and a surface potential of the image-receiving unit generate a discharging at the image section and do not generate a discharging at the non-image section. Claim 5 of US Patent No. 6,792,222 recites the same elements that read on the method of the instant invention's claim 2. That is the image-receiving unit is an intermediate transfer unit that transfers a primary-transfer toner image on the image holder onto a transfer material as a secondary transfer. Claim 1 of US Patent No. 6,792,222 recites the same elements that read on the method of the instant invention's claim 3. That is the surface potential V_{t1} of the image receiving unit satisfy the equation as stated in claim 1 of US Patent No. 6,792,222 (note column 14, lines 15-23) is the same as the instant invention's. Claim 5 of US Patent No. 6,792,222 recites the same elements that read on the method of the instant invention's claim 4. That is the relationship (equation) as stated in claim 5 of US Patent No. 6,792,222 (note column 14, line 63-column 15, line 8) is the same as that in the instant invention's claim 4. Claim 2

of US Patent No. 6,792,222 recites the same elements that read on the method of the instant invention's claim 5. That is potential difference V_d , at which a discharging is started between two objects in the environment of forming an image is set to 320 V. Claim 3 of US Patent No. 6,792,222 recites the same elements that read on the method of the instant invention's claim 6. That is a material that constitutes the image-receiving unit has a volume resistance of 1×10^3 to $10^{10} \Omega \text{ cm}$. Claim 6 of US Patent No. 6,792,222 recites the same elements that read on the method of the instant invention's claim 7. That is a material that constitutes the intermediate transfer unit has a volume resistance of 1×10^3 to $10^{10} \Omega \text{ cm}$. Claim 8 of US Patent No. 6,792,222 recites the same elements that read on the method of the instant invention's claim 8. That is a potential-difference amplifying unit that amplifies a potential difference between the image section and the non-image section of the image holder prior to the transfer of the toner image onto the image-receiving unit (note column 15 of US Patent No. 6,792,222, line 31- column 16, line 3). Claim 9 of US Patent No. 6,792,222 recites the same elements that read on the method of the instant invention's claim 9. That is the potential-difference amplifying unit amplifies the potential difference by irradiating the irradiated beam onto the toner image after the surface of the image holder has been re-charged (note column 16 of US Patent No. 6,792,222, lines 21-24). Claim 4 of US Patent No. 6,792,222 recites the same elements that read on the method of the instant invention's claim 10. That is the developing unit is a wet-type developing unit that develops an electrostatic latent image formed on the image holder, by using a liquid developing agent (note column 14 of US Patent No. 6,792,222, lines 38-40).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan S. Lee whose telephone number is 571-272-2137. The examiner can normally be reached on Mon. - Fri., 10:30-8:00, Second Monday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Art Grimley can be reached on 571-272-2136 or 571-272-2800 (Ext. 52). The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Susan S. Lee
Primary Examiner
Art Unit 2852

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